

DOCKET NO: 296452US6PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TORU TORII, ET AL. : EXAMINER: HAIDER, S. B.
SERIAL NO: 10/593,783 :
FILED: FEBRUARY 2, 2007 : GROUP ART UNIT: 1796
FOR: METHOD AND DEVICE FOR :
PRODUCING MICRO-DROPLETS :

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement in the Official Action mailed March 12, 2010, Applicants provisionally elect, with traverse, Group II, Claims 9-14 and 19-20, drawn to an apparatus for producing microdroplets, for further examination on the merits in the present application. Applicants reserve the right to file one or more divisional applications directed to the non-elected invention.

The Restriction Requirement states the following:

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2 they lack the same or corresponding special technical features for the following reasons: Claim 1 is either obvious over or anticipated by Higuchi et al. (U.S. 7,268,167). Accordingly, the special technical feature linking the two inventions, the intersection of the phases resulting in the formation of sequentially produced microcapsules, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, restriction is appropriate.

However, 37 C.F.R. §1.475 states the following:

a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. **The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.**

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process;
or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process. [Emphasis added].

Applicants respectfully submit that Group I, Claims 1-8 and 15-18 drawn to a method for producing microdroplets, and Group II, Claims 9-14 and 19-20, drawn to an apparatus for producing microdroplets, clearly fall under category (4) listed above as a process and an apparatus or means specifically designed for carrying out the said process. Therefore, Applicants submit that Claims 1-20 must be considered to have unity of invention.

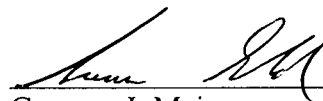
Additionally, the examiner has merely stated that Claim 1 is either obvious over or anticipated by Higuchi et al. (U.S. 7,268,167), but has made no specific showing of obviousness or anticipation such that the common technical features that the examiner has identified for each of the groups have been shown to make no contribution over the prior art. The examiner has merely cited to Higuchi et al. (U.S. 7,268,167) without any specific citations or analysis.

Therefore, Applicants respectfully submit that the Restriction Requirement does not meet both requirements (a) and (b) under 37 C.F.R. §1.475, and therefore has not properly shown a lack of unity of invention.

Therefore, it is respectfully submitted that the Restriction Requirement is improper and must be withdrawn, and it is respectfully requested that a full examination on the merits of Claims 1-20 be conducted.

Respectfully submitted,

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